

REMARKS

Claims 1-8, 12-24, 81, and 82 have been amended. Claims 25-80 have been cancelled without prejudice or disclaimer as to the subject matter contained therein. Therefore, claims 1-8, 12-24, and 81-83 are pending in the present application. It is respectfully submitted that no new matter has been presented and no new issues have been raised by the present response. Further examination and reconsideration of pending claims 1-8, 12-24, and 81-83 are respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-8 and 12-80 were rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure that is not enabling. As noted above, claims 25-80 have been cancelled thereby rendering the § 112, first paragraph, rejections of these claims moot. As set forth in detail below, the § 112, first paragraph, rejections of claims 1-8 and 12-24 are respectfully traversed.

In particular, the Final Office Action states:

The tip and its relationship to the nozzle is considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure...It is unclear how the device can operate as claimed without the tip being claimed.

(Final Office Action -- pages 5-6). Applicants respectfully submit that it is clear how the device can operate without the tip being claimed. Nevertheless, for clarification purposes only, independent claim 1 has been amended to recite, in part:

the nozzle portion is configured such that a pipette tip can be mounted to an end of the nozzle portion in fluid communication with the nozzle portion; and at least one button...operable by a thumb of the operator to effect aspiration of liquid into the pipette tip mounted to the end of the nozzle portion and dispensing of the liquid from the pipette tip mounted to the end of the nozzle portion.

Applicants respectfully submit that the amendments to claim 1 clarify how the claimed device can operate and such operation of the device is enabled by the disclosure.

Support for the amendments to claim 1 can be found in the Specification, for example, on page 3, lines 27-28 and in matter incorporated into the Specification on page 7, lines 24-28. Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. MPEP 2163.07(b). As such, the above-referenced amendments to claim

1 do not present new matter, and entrance of these amendments to claim 1 is respectfully requested.

For at least the reasons set forth above, claim 1 and claims 2-8 and 12-24 dependent therefrom are supported by an enabling disclosure. Accordingly, removal of the § 112, first paragraph, rejections of claims 1-8 and 12-24 is respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-2, 4-5, 12-13, 15-24, 30, 31, 36, 38-41, 45-52, 54-58, 60, 61, 65, 66, 68-72, and 74-80 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,246,559 to Clifford (hereinafter "Clifford"). As noted above, claims 30, 31, 36, 38-41, 45-52, 54-58, 60, 61, 65, 66, 68-72, and 74-80 were canceled thereby rendering the § 102 rejections of these claims moot. As will be set forth in detail below, the § 102 rejections of claims 1-2, 4-5, 12-13, and 15-24 are respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. The cited art does not

disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

In particular, it is respectfully submitted that Clifford does not teach every element recited in amended independent claim 1, including:

- "A handheld pipette including:...a piston member operable for controlling flow of the liquid aspirated into the pipette tip such that the liquid cannot enter into the nozzle portion and thereby cannot move through the body portion".

Support for the amendments to claim 1 can be found in the Specification, for example, on page 7, lines 19-28, page 9, line 24 to page 10, line 2, and in matter incorporated into the Specification on page 7, lines 24-28.

Clifford discloses a force fed cuvette. For example, Clifford discloses that a user can force fluid from a test tube into a capillary tube of the apparatus (and thereby into a cuvette of the apparatus) by covering a vent with the user's finger and forcing a finger of the apparatus, in which the capillary is disposed, into the test tube. (Clifford -- col. 3, lines 44-53 and col. 4, lines 31-39). Clifford also discloses that a plunger of the apparatus can be manipulated by

the user to draw fluid through the capillary and into the cuvette. (Clifford -- col. 4, lines 59-61). Therefore, the user of the apparatus of Clifford controls the flow of liquid into the capillary and thereby into the cuvette.

Clifford also does not disclose that the apparatus is configured such that a pipette tip can be mounted thereon as presently claimed. In particular, Clifford does not teach or suggest that the cuvette is configured such that "a pipette tip" can be mounted thereon as recited in amended independent claim 1. Rather, Clifford describes and illustrates a finger-like member 64 with an enlarged end 65 dimensioned to snugly receive a test tube 70 (Clifford -- col. 3, lines 30-35).

However, assuming *arguendo* that one considers capillary 23 as a pipette tip, it is respectfully submitted that there is no teaching or even suggestion in Clifford of aspirating liquid into the capillary and dispensing the liquid from the capillary without the liquid entering into a nozzle portion. Moreover, Clifford does not teach a piston member operable for controlling flow of liquid into the capillary and into the cuvette.

In the "Response to Arguments" section of the Final Office Action, the Examiner states:

If one chooses to retract the plunger of Clifford a relative small distance, liquid

will only enter the tube 23 at the immediate portion which terminates in the liquid. One does not have to retract the plunger far enough to withdraw fluid or liquid into any other portions of the device.

(Final Office Action -- Page 3). Applicants respectfully submit that there is no teaching, suggestion, or motivation in the teachings of Clifford to "retract the plunger of Clifford a relative small distance, [so that] liquid will only enter the tube 23 at the immediate portion which terminates in the liquid." Clifford discloses a force fed cuvette; accordingly, Clifford expressly teaches liquid traveling from test tube 70 to cuvette 25 within holder 11 and there is no suggestion that liquid does anything other than enter cuvette 25.

However, here again, assuming *arguendo* that the plunger of Clifford can be retracted in such a manner, according to the teachings of Clifford, the user retracts the plunger and therefore controls flow of fluid into the apparatus of Clifford. Furthermore, Clifford does not teach that the plunger itself is operable to control the flow of the liquid into the capillary and into the cuvette.

For at least the reasons set forth above, therefore, Clifford does not teach a handheld pipette that includes a piston member operable for controlling flow of liquid aspirated into a pipette tip such that the liquid cannot enter into a

nozzle portion of the pipette and thereby cannot move through a body portion of the pipette, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

Furthermore, the above-referenced limitations of claim 1 do not constitute a manner in which the claimed pipette is intended to be employed. Instead, the above-referenced claim language is structurally limiting because the claim language limits the structure to structures that can control the flow of the liquid aspirated into the pipette tip. Therefore, the language added to claim 1 in the current amendment constitutes structural claim limitations. As such, the presently claimed pipette is distinguished from the prior art apparatus of Clifford in terms of structure rather than function. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). MPEP 2114. Therefore, even if the apparatus of Clifford could be used in a manner such that the user controls flow of liquid into the capillary, the prior art apparatus does not teach all structural limitations of the claim. As such, the claimed pipette is differentiated from the prior art apparatus of Clifford. A

claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex Parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). MPEP 2114. (emphasis in original).

As noted above, claims 2, 4-5, 12-13, and 15-24, which depend from claim 1, were rejected as being anticipated by Clifford. The Office Action, however, does not provide support or basis for the § 102 rejections of claims 2, 4-5, 12-13, and 15-24. Applicants reserve the right to argue the patentability of these dependent claims upon being presented with support or basis for these rejections.

For at least the reasons set forth above, claim 1 is not anticipated by the cited art. Therefore, claims 2, 4-5, 12-13, and 15-24, which depend from claim 1, are not anticipated by the cited art for at least the same reasons. Accordingly, removal of the § 102 rejections of claims 1-2, 4-5, 12-13, and 15-24 is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 3, 6-8, 25-29, 32-35, 42-44, and 62-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Clifford in view of U.S. Patent No. 2,796,204 to Math (hereinafter "Math"). Claims 14, 47, 67, and 81-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clifford in view of U.S. Patent No. 6,737,023 to Kelly et al. (hereinafter "Kelly"). Claims 20, 37, 53, and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clifford in view of U.S. Patent No. 5,983,733 to Strandberg et al. (hereinafter "Strandberg"). As noted above, claims 25-29, 32-35, 37, 42-44, 47, 53, 62-64, 67, and 73 have been cancelled thereby rendering the § 103 rejections of these claims moot. As will be set forth in detail below, the § 103 rejections of claims 3, 6-8, 14, 20, and 81-83 are respectfully traversed.

The cited art does not teach, suggest, or provide motivation for a handheld pipette that includes a piston member operable for controlling flow of liquid aspirated into a pipette tip such that the liquid cannot enter into a nozzle portion of the pipette and thereby cannot move through a body portion of the pipette, as recited in claim 1. As set forth in detail above, Clifford does not teach all limitations of claim 1. Claim 81 was amended to recite similar limitations. Therefore, Clifford does not teach all limitations of claim 81.

Clifford also does not suggest or provide motivation for all limitations of claims 1 and 81. For example, as shown in

Figs. 1 and 2 of Clifford, fluid in test tube 70 enters capillary 23 which extends to the lower end of cuvette 25. Therefore, if, for the sake of argument, the capillary of the apparatus of Clifford is considered to be a "pipette tip," the cuvette in fluid communication with the capillary is a "nozzle portion." As such, if the apparatus of Clifford is modified such that the apparatus is operable for controlling flow of liquid aspirated into the capillary such that the liquid cannot enter the cuvette in fluid communication with the capillary, the invention of Clifford would be modified unsatisfactory for its intended purpose. In particular, Clifford states:

it is an object of the invention to provide an improved cuvette assembly designed for momentary insertion into an optical analyzing apparatus, such as a colorimeter, and provided with simple means for forcing fluids into the cuvette and withdrawing them therefrom.

(Clifford -- col. 1, lines 41-45). Therefore, modifying the apparatus of Clifford such that the apparatus is operable for controlling the flow of the liquid such that the liquid cannot enter the cuvette would render the invention of Clifford unsatisfactory for its intended purpose since the fluid could not be introduced into the cuvette for optical analysis. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then

there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01(V.).

Furthermore, even if Clifford could be combined with or modified by other cited art such that the apparatus of Clifford is operable for controlling the flow of the liquid as presently claimed, the cited art does not suggest the desirability of modifying the apparatus of Clifford in such a manner for at least the reasons set forth above. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01(III.). (emphasis in original). In addition, none of the other cited art suggests the desirability of modifying an apparatus such as that of Clifford such that the apparatus is operable for controlling the flow of the liquid as presently claimed. Therefore, even if the cited art can be combined to arrive at the presently claimed pipette, the resultant combination is not obvious.

Moreover, Math and Kelly do not teach, suggest, or provide motivation for a pipette that includes a piston member operable for controlling flow of liquid aspirated into a pipette tip

such that the liquid cannot enter into a nozzle portion of the pipette and thereby cannot move through a body portion of the pipette, as recited in claim 1 and 81. As such, Math and/or Kelly do not teach, suggest, or provide motivation for all limitations of claims 1 and 81 and cannot be combined with Clifford to overcome the deficiencies in the teachings contained therein.

Strandberg discloses a manual pipette. Strandberg states that "FIGS. 1, 2A and 2B show the volume adjuster 51 and its ability to reset both the counter 48 and the pipette 10 in accordance with the desired volumetric quanta to be pipetted." (Strandberg -- col. 7, lines 31-34). Although Strandberg discloses a pipette that includes a volume adjuster configured to control the volume pipetted by the pipette, for at least the reasons set forth above, modifying the apparatus of Clifford such that the apparatus of Clifford is configured to control the flow of the liquid as presently claimed is not obvious. Therefore, Strandberg does not teach, suggest, or provide motivation for all limitations of claims 1 and 81 and cannot be combined with Clifford to overcome the deficiencies in the teachings contained therein.

For at least the reasons set forth above, claims 1 and 81 are patentable over the cited art. Therefore, claims 3, 6-8,

14, 20, and 82-83 dependent therefrom are patentable over the cited art for at least the same reasons. Accordingly, removal of the § 103 rejections of claims 3, 6-8, 14, 20, and 81-83 is respectfully requested.

"Response to Arguments" section of the Final Office Action

The Final Office Action states:

As to claim 22 (and any other structural claim), which is directed to how one intends for the device to be held, the examiner asserts an operator can choose how the device is arranged in one's hands and furthermore control the pressure which one holds the device with.

(Final Office Action -- page 2). Applicants respectfully traverse this assertion. In particular, amended claim 22 recites, in part: "the portions of said pipette which come in contact with the operator's hand are shaped so that the contact pressure at no point on said pipette exceeds 14 psi."

Therefore, the above-referenced language of claim 22 is structurally limiting because the claim language limits the structure of these portions of the pipette to structures having shapes that limit the contact pressure as presently claimed. Therefore, the limitations of claim 22 are not directed to an intended use or a process of using the pipette and do limit the structure of the pipette.

The Final Office Action also states:

The amendment is unclear for if the device is operated so that liquid does not enter nozzle, then it is unclear how liquid is aspirated and dispensed. There is no additional structure claimed as to determine if liquid ever enters the device at all. If no liquid enters the device aspiration or dispensing cannot occur as asserted by the claim.

(Final Office Action -- page 2). For clarification purposes only, claim 1 has been amended to recite, in part:

at least one button...operable...to effect aspiration of liquid into the pipette tip mounted to the end of the nozzle portion and dispensing of the liquid from the pipette tip mounted to the end of the nozzle portion...a piston member operable for controlling flow of the liquid aspirated into the pipette tip such that the liquid cannot enter into the nozzle portion and thereby cannot move through the body portion.

Claim 81 has been amended to recite similar limitations.

Support for the amendments to claims 1 and 81 can be found in the Specification, for example, on page 7, lines 19-28, page 9, line 24 to page 10, line 2, and in matter incorporated into the Specification on page 7, lines 24-28. The amendments to claims 1 and 81, therefore, clarify how the pipette effects aspiration and dispensing of a liquid and controls flow of the liquid aspirated into the pipette tip such that the liquid cannot enter into the nozzle portion. As such, the amendments to the

claims clarify how aspiration and dispensing can occur without liquid entering the pipette.

The Final Office Action states:

It should be further noted that when the device of Clifford is operated to aspirate or dispense liquid, such liquid only passes through or contacts capillary 23, the liquid never enters or contacts elements 64, 62, 65, or 67 all of which may be considered as a nozzle of the device. As such, Clifford is considered to meet the limitations of claim as broadly interpreted.

(Final Office Action -- page 3). Applicants respectfully traverse this assertion. In particular, elements 64, 62, 65, or 67 of Clifford cannot be considered a nozzle portion as presently claimed since these elements are not in fluid communication with capillary 23. In contrast, cuvette 25 of Clifford is in fluid communication with capillary 23. In addition, as set forth in more detail above, Clifford does not teach, suggest, or provide motivation for a piston member operable for controlling flow of the liquid into the capillary such that the liquid cannot enter into the cuvette. Clifford also does not teach, suggest, or provide motivation for a piston member operable for controlling the flow of the liquid into the capillary such that the liquid cannot move through the body portion of the apparatus of Clifford. It is noted that a liquid moving through a "body portion" does not have to contact

the "body portion." Instead, a liquid can move through a body portion by moving through a conduit disposed within the body portion. For at least the reasons set forth above, the apparatus of Clifford cannot be considered to meet the limitations of the present claims as broadly interpreted.

The Final Office Action further states that "Applicant asserts that the examiner has not addressed a number of elements. While the examiner disagrees, and believes the elements have been clearly addressed." (Final Office Action -- page 4). The Final Office Action includes a number of assertions about the cited devices and references on page 4 of the Final Office Action without providing support for these assertions. Accordingly, Applicants respectfully request that, if these assertions are maintained, specific portions of the references used to reject specific claims be included in the next Office Action such that Applicants can fully respond to these assertions. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. MPEP 706.

Other Remarks in the Final Office Action

Regarding the remarks contained in the section of the Final Office Action entitled "Claim Interpretations," the Final Office Action states that "As to those claims that are directed to the manner in which the device is used (such as claim 4) the examiner asserts one may use the devices of the instant invention as well as the prior art as one so desires." (Final Office Action -- page 4). Applicants respectfully traverse this assertion. In particular, amended claim 4 recites, in part: "said angle θ is such as to permit at least one of the operator's wrist, elbow and shoulder to be in a substantially natural position when the pipette is performing a pipetting operation." As such, the above-referenced language of claim 4 is structurally limiting because the claim language limits the angle to angles that permit the operator's wrist, elbow and shoulder to be positioned as presently claimed. Therefore, the limitations of claim 4 are not directed to an intended use or a process of using the pipette and do limit the structure of the pipette.

The "Claim Interpretations" section of the Final Office Action also includes certain assertions with respect to claims 25, 31-37, and 41. While Applicants respectfully traverse these assertions, as noted above, claims 25, 31-37, and 41 have

been canceled thereby rendering these assertions moot.

Therefore, reasons for traversing these assertions will not be presented herein.

Claim Elements Not Addressed In the Final Office Action

It is respectfully submitted that the Final Office Action has not addressed several elements recited in the pending claims of the present application, including at least:

- "a nozzle portion extending from a point on said body portion and at a downward angle θ of approximately 60° to 80° to the vertical central axis of said body portion," as recited in amended claim 1;
- "said angle θ is adjustable," as recited in amended claim 3;
- "said at least one button is operated in a direction at a selected angle to said nozzle portion," as recited in amended claim 12;
- "a button on said body which controls ejection of a tip from said nozzle portion, said button being shaped to minimize contact pressure on the operator's hand when the button is operated", as recited in amended claim 14;

- "said body portion has a stable base permitting said pipette to stand on a surface with the vertical central axis of the body portion substantially perpendicular to the surface," as recited in amended claim 16;
- "wherein said nozzle portion is operable for receiving the pipette tip, including at least the angle θ of said nozzle portion to the vertical central axis of said body portion and length of said tip affixed to said nozzle portion, are selected such that said tip does not touch a surface on which the pipette is standing," as recited in amended claim 17;
- "said body portion has a bottom which is removable at least in part to provide access to the pipette," as recited in amended claim 18; and
- "an adapter selectively mountable to said body portion, said adapter adjusting the size of said body portion to better fit operator hand size," as recited in amended claim 19.

Accordingly, Applicants respectfully request that each of these elements be addressed either by being rejected over one or more prior art references or by allowing the associated claims.

Conclusion

This communication is believed to be fully responsive to the Final Office Action and every effort has been made to place the application in condition for allowance. The claims are believed to be patentable over the cited references, and a favorable Office Action is hereby earnestly solicited.


If an additional telephone interview would be of assistance in advancing prosecution of the present application, the Examiner is respectfully invited to telephone the undersigned at the number provided below.

If any fee is due in connection with the present response, the Commissioner for Patents is hereby authorized to charge the requisite fee to our deposit account number 02-0393.

Respectfully submitted,

Date: January 5, 2007

By:


Frank M. Gasparo
Registration No. 44,700
Baker & McKenzie LLP
1114 Avenue of the Americas
New York, NY 10036
Telephone (212) 626-4100
Facsimile (212) 310-1600